DOCKET NO.: 286664US8PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: GROUP: 2169

Takeshi IWATSU, et al.

SERIAL NO: 10/573,418 EXAMINER: TRUONG, D.

FILED: March 27, 2006

FOR: INFORMATION REPRODUCTION DEVICE AND METHOD, AND PROGRAM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

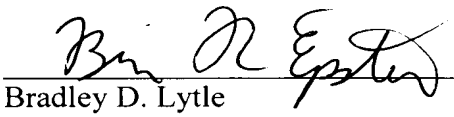
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



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REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants request a Pre-Appeal Brief Conference be initiated in accordance with the Pilot Program outlined in the Official Gazette Notice of July 12, 2005, and extended in the Official Gazette Notice of February 7, 2006.

GROUNDS FOR REVIEW

The Office Action issued January 18, 2011, (hereinafter "Office Action") rejected, *inter alia*, independent Claims 1 and 12-14 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,757,708 to Craig et al. (hereinafter "Craig") in view of U.S. Patent No. 6,681,298 to Tso et al. (hereinafter "Tso"), U.S. Patent App. Publ'n No. 2002/0002625 to Vange et al. (hereinafter "Vange"), and U.S. Patent No. 6,986,018 to O'Rourke et al. (hereinafter "O'Rourke"). Because Tso, Vange, and O'Rourke fail to remedy the

acknowledged deficiencies in Craig, that rejection is erroneous for failing to have established a *prima facie* case of obviousness regarding the features of those claims. In particular, the Office committed at least three clear errors:

1) None of the applied references provides substantial evidence rendering obvious the Office's proposed modifications of the Tso removal factors.

2) The Office applied inconsistent interpretations of a "vendor" in suggesting it would have been obvious to modify Vange in view of O'Rourke.

3) The Office's alternative view of a "vendor" in Vange creates new deficiencies in the applied references unappreciated by the Office.

None of the applied references provides substantial evidence rendering obvious the Office's proposed modifications of the Tso removal factors.

In rejecting the independent claims, the Office Action proposed to modify the Tso removal factors based on the O'Rourke description of caching content only from specific origin servers.[1] Arguments directed to this improper modification were set forth in the Request for Reconsideration filed March 15, 2011 (hereinafter "Request for Reconsideration").[2] The Advisory Action issued March 30, 2011, (hereinafter "Advisory Action") replied that "a particular vendor can be removed by only using the website associated with the vendor as [an] input in calculating a removal factor, or a particular file type [can] be removed also by using one file type input when calculating the removal factor . . . ."[3]

Whether files of a particular vendor or of a particular file type ***could have been*** removed is beside the point. Rather, the obviousness inquiry focuses on whether it would

[1] Office Action at 6-7.
[2] Request for Reconsideration at 6-7.
[3] Advisory Action at 2.

have been obvious to modify the Tso removal factors to do so. In this regard, the applied references fail to render obvious the Office's proposed modification.

For example, Tso does not disclose or suggest removing all files except for those of a particular website. Further, none of the other references discloses or suggests modifying the Tso removal factors to remove all files except for those of a website.

In addition, even assuming a particular file type can be removed in Tso, the mere removal of a file type does not disclose or suggest removing all files ***except*** for files of that file type. None of the other references would have rendered obvious such a modification.

The Office applied inconsistent interpretations of a "vendor" in suggesting it would have been obvious to modify Vange in view of O'Rourke.

In addition, the Office proposed to modify a Vange format creation group in view of an O'Rourke server owner.[4] As the basis for its proposed modification, the Office asserted, "it would have been reasonable to interpret a 'vendor' as the company or group that created [a] particular content data type/format."[5]

The Request for Reconsideration addressed this position.[6] However, the Office's reply indicates the Office apparently missed the thrust of Applicants' contention. Applicants do not address the propriety of the Office's interpretation of a vendor and instead direct attention to the fact of the ***multiple, different*** interpretations of a vendor proffered by the Office.

Under the Office's interpretation, the Vange vendor is a group that created, e.g., the JPEG format (i.e., Joint Photographic Experts Group). Meanwhile, the Office apparently interpreted as a vendor the O'Rourke company or organization owning the origin server. However, a group's creation of a data format does not disclose or suggest their ownership of

[4] Office Action at 5-6.
[5] Advisory Action at 2.
[6] Request for Reconsideration at 5.

a server. Further, even assuming the group owns a server, the ownership does not disclose or suggest a format of content transmitted from the server.

That is, the Office's interpretation of a vendor ***as applied to*** Vange is different from the interpretation of a vendor ***as applied to*** O'Rourke. The Office proposed to modify the asserted Vange vendor in view of the O'Rourke server owner. However, the Office provided no evidence that such a modification would have been obvious.

The Office's alternative view of a "vendor" in Vange creates new deficiencies in the applied references unappreciated by the Office.

Perhaps in view of the above issue, the Advisory Action newly proposed a different interpretation of the Vange vendor. Specifically, the Advisory Action relied on a Vange back-end, from which a corresponding front-end decompresses graphics, as disclosing the recited vendor.[7] The Advisory Action did not otherwise explain how the references would be applied in view of that new position.

Despite the Office's new view, the references nevertheless fail to present a *prima facie* case of obviousness for at least two reasons. For example, Vange merely describes reformatting when a graphics format cannot be interpreted by the client.[8] Vange does not disclose or suggest that the front-end registers the decompressed graphics in response to identification information identifying the back-end. Indeed, the Office Action did not rely on Vange as disclosing a registration in response to identification information.[9]

Further, the Advisory Action did not address whether it would have been obvious to modify Tso in view of the new Vange interpretation. As discussed above, Tso does not disclose or suggest using a web page as an input to the Tso arithmetic function generator.

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[7] Advisory Action at 2; Vange, para. [0075].
[8] Vange, para. [0072].
[9] See Office Action at 5-6.

Further, the Vange description of a back-end would not have rendered obvious modifying the Tso removal factors in view of the back-end.

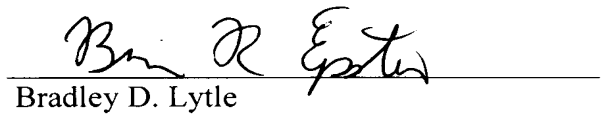
CONCLUSION

As detailed above, the outstanding rejections are premised on modifying the actual teachings of the applied references, and such modifications using unfounded assumptions and/or speculation are improper.[10]

Thus, the current grounds of rejection have not been clearly developed to such an extent that Applicants can readily judge the advisability of preparing a traditional appeal brief.[11] Accordingly, Applicants respectfully request that prosecution be re-opened.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



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[10] See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) ("The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because ***it*** may ***doubt*** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.").
[11] See MPEP § 706.07.